



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO. 09/806,393	FILING DATE 03/23/98	SCHIRMER FIRST NAMED INVENTOR	PI	ATTORNEY DOCKET NO. 1164/71695
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QM21/0111

WELSH & KATZ  
120 SOUTH RIVERSIDE PLAZA  
22ND FLOOR  
CHICAGO IL 60606

MARLO, G. EXAMINER

ART UNIT

PAPER NUMBER

01/11/00

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

Art Unit: 3711

This Office action is responsive to a letter received October 04, 1999 and styled  
**"PETITION TO CORRECT INVENTORSHIP UNDER 37 C.F.R. 1.48(b)".**

The petition identifies that Thomas Musial is to be deleted as an inventor in this application because his invention is no longer being claimed. The attorney of record attests to having reviewed the application and allowed claims and notes that he takes full responsibility for insuring that the inventor, Thomas Musial, has not been improperly deleted from the application. The petition includes the appropriate fee.

37 CFR 1.48(b) provides for deleting the names of persons originally properly included as inventors, but whose invention is no longer being claimed in a nonprovisional application. Such a situation would arise where claims have been amended or deleted because they are unpatentable or as a result of a requirement for restriction of the application to one invention, or for other reasons. A petition under 37 CFR 1.48(b) to delete an inventor would be appropriate prior to an action by the examining group where it is decided not to pursue particular aspects of an invention attributable to some of the original named inventors. However, a petition under 37 CFR 1.48(b) is not an available means to avoid execution of the application as originally filed under 37 CFR 1.53(b)(1) situations. Public Law 98 - 622 and 37 CFR 1.48(b) change the result reached in *Ex parte Lyon*, 146 USPQ 222, 1965 C. D. 362 (Bd. App. 1964). 37 CFR 1.48(b) requires only a petition and fee with the petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application. The amendment would have to be diligently made under 37 CFR 1.48(b). The statement may be signed by applicant's registered attorney or agent who then takes full responsibility for ensuring that the inventor is not being improperly deleted from the application. Written consent of any assignee is not required for petitions filed under 37 CFR 1.48(b).

When any correction or change is effected, the file should be sent to the Application Division for revision of its records and the change should be noted on the original oath or declaration by writing in red ink in the left column "See Paper No. \_\_\_ for inventorship changes". See MPEP § 605.04(g).

In view of the papers filed 10-04-99, the inventorship in this nonprovisional application has been changed by the deletion of Thomas Musial.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.


Art Unit: 3711

The examiner of record in this application has changed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the Primary Examiner, Sebastiano Passaniti, whose telephone number is (703)308-1006.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on (703) 308-1310. The formal fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579. The informal fax phone number is (703) 308-7768. Applicant is strongly urged to contact or leave voice mail notification with the examiner just prior to sending an informal facsimile transmission.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

S. Passaniti/ sp  
January 10, 2000

  
**SEBASTIANO PASSANITI**  
**PRIMARY EXAMINER**  
**ART UNIT 3711**